

REMARKS

I. Status of the Claims

Claims 1-26 were originally filed, and claims 27-35 were later added. Subsequently, claim 9-12, 22, 24, 25, and 27-30 were canceled. Claims 1-8, 13-21, 23, 26, and 31-35 were pending under examination.

Upon entry of the present amendment, claims 31 and 35 are canceled without prejudice to future revival. Claims 14 and 32 are amended to recited the specific characteristics of heterologous bispecific antibodies, which is found in claim 1. Claims 23 and 32 are amended to reword the language "such tumor cells have appeared" to ensure proper antecedent basis. Claim 23 is further reworded to render improved clarity to the claim language. The present amendment adds no new matter.

III. Claim Rejections

A. 35 U.S.C. §112, Second Paragraph

Claims 14, 23 and 31-35 were rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. Specifically, the Examiner asserted that the recitation "said intact heterologous bispecific antibodies" in claim 14, "such tumor cells" in claim 23, "said intact heterologous bispecific antibodies" in claim 32, and "such tumor cells" in claim 32 lack antecedent basis. The Examiner also asserted that claims 31 and 35 apparently have the same scope.

Claims 14 and 32 have been amended to explicitly recite the characteristics of the heterologous bispecific antibodies, which can be found in claim 1. Claims 23 and 32 have been amended to reword the language "in whom such tumor cells have appeared," according to the Examiner's suggestion, to "in whom tumor cells have reappeared." Further, claims 31 and 35 have been canceled. Applicants submit that the indefiniteness rejections are overcome in view of the present claim amendment. The Examiner's helpful suggestion in regard to the amendment is very much appreciated.

B. 35 U.S.C. §102

Claims 31 and 35 were rejected under 35 U.S.C. §102(b) for alleged anticipation by Honsik *et al.* (U.S. Patent No. 4,844,893) or by Renner *et al.* (Science 264:833-835, 1994). Although Applicants do not agree with the Examiner's opinion that the two above-named references anticipate the claimed invention, to ensure early issuance of the remaining claims, claims 31 and 35 have been canceled without prejudice to future revival. The anticipation rejection is thus moot.

C. Provisional Double Patenting Rejection over USSN 10/378,218

Claims 1-8, 13-21, 23, and 26 remained provisionally rejected under the judicially created doctrine of the obviousness-type of double patenting over claims 1, 7, 10, 19, 22, and 23 of USSN 10/378,218.

Applicants submit that the Examiner should withdraw the provisional double patenting rejection and allow the claims pending in the present application. According to the MPEP §822.01, “[i]f the “provisional” double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent...” This is precisely the case in the present application, as the only other remaining rejections, the indefiniteness rejection and the anticipation rejection, have been fully addressed in light of the present claim amendment. On the other hand, USSN 10/378,218 has not been allowed. Thus, Applicants respectfully request that the Examiner withdraw the provisional double patenting rejection and allow the pending claims in the present application to issue.

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PATENT

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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